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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/997,489	12/23/97	DENNIS	C 51410-P003US
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EXAMINER

GROUTT, P

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

02/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/997,489

Applicant(s)

Charles L. Dennis

Examiner

Phillip Groult

Group Art Unit

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☒ Responsive to communication(s) filed on Dec 23, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-105 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-75, 77-94, and 96-105 is/are rejected.

☒ Claim(s) 76 and 95 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-7, 11-19, 21, 23-39, 44-59, 64-75, 77-83, 85-94, and 96-105 rejected under 35 U.S.C. 102(e) as being anticipated by Joao et al, US 5,878,337, herein after Joao.

As to claim 1, Joao teaches a system for controlling financial transactions using a wireless network, where in customers having wireless devices desire to complete particular transactions, see column 4, lines 30-60. Joao also teaches means for receiving transaction amounts from a wireless network as well as means for displaying transaction amounts, see column 6, lines 33-43.

As to claim 2, Joao teaches means for customers to verify the displayed transaction amounts at column 6, lines 44-51.

As to claim 3, the system of Joao is directed to point of sale transactions.

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As to claim 4, the amounts displayed in Joao are amounts to be posted on billing statements.

As to claim 5, the system of Joao teaches means for charging said transaction amounts to a source of funds selected by said customers. ***"The apparatus and method of the present invention, which is utilized in conjunction with a credit card, a charge card, a debit card and/or a currency or smart card..."***, column 4, lines 4-10.

As to claims 6 and 7, Joao teaches that the source of funds can be a bank account or credit card account.

As to claim 11, Joao teaches that different sources of funds can be identified for different types of transactions. In one embodiment, Joao teaches using a credit card and in another he teaches using the system for remote ATM transactions.

As to claim 12, the system of Joao teaches a point-of-sale terminal, item 2, means for communication a particular transaction amount from said point of sale terminal to a database, see figure 2, item 3H, and means for associating said particular transaction in said database with a particular customer so that the transaction amount displayed to said customer is a transaction occurring in real-time with respect to said customer. Examiner asserts that this is precisely how the system of Joao functions.

As to claim 13, Joao teaches means for transmitting an identity code from customer's wireless device to a wireless network and means for correlating the transmitted identity code with a particular transaction occurring at a particular point-of-sale. In Joao, the customer responds via

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his wireless devices sending his response in association with the number of his devices. This information about the number is associated by the wireless network with all transmissions by the device. The central processing system of Joao then associates this with the specific transaction at the specific point-of-sale terminal that the transmission is in response to.

As to claims 14-19, they are rejected on substantially the same basis as claims 1-8 as discussed above.

As to claims 23 and 24, they are rejected on substantially the same basis as claims 11 and 12 as discussed above.

As to claim 25, it is rejected on substantially the same basis as claim 13 as discussed above.

As to claim 26, Joao teaches a system for controlling financial transaction over a wireless network as discussed above in regard to claim 1. The system of Joao has point-of-sale locations wherein said terminals contain transaction information, see figure 2 and the abstract. The system of Joao also contains a financial gateway coupled to said terminals wherein said financial gateway receives said transaction information, see column 5, lines 39-51. The system of Joao also incorporates a wireless network coupled to the financial gateway, where in the wireless network is operable to transmit said transaction information for display on wireless devices and means for directing particular transaction information to a particular wireless device. He does not explicitly state a wireless network, however, this is inherent and necessary to his system. At column 6, lines 5-20, Joao states, *"...the central processing computer may transmit a signal*

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and/or data to the communication device which is located with the cardholder. The central processing computer may then also transmit respective signals an/or data to any one or more of the cardholder's designated fax machine, personal computer, telephone, alternate telephone answering machine, network computer, and/or alternate beeper or pager, either sequentially or simultaneously." Clearly this requires the central processing computer or financial gateway to be coupled to a wireless network.

As to claim 27, Joao teaches means for allowing customer to complete said financial transactions by verifying said displayed transaction information at column 6, lines 44-55.

As to claim 28, it is rejected on the same basis as claim 26 as discussed above.

As to claims 29 and 30, they state that the financial gateway is coupled to the point-of-sale terminals through a data network or the Internet respectively. Joao merely states that they are coupled, thus the nature of the network connecting them imparts no patentable distinction.

As to claim 31, Joao teaches that the transaction information comprises the cost of the transaction.

As to claim 32, Joao teaches that transaction information comprises an identity of said point of sale location at column 5, lines 35-39. *"The information and/or data pertinent to the transaction and the card is then transmitted to the central processing computer."*

As to claim 33, Joao teaches that the wireless devices display the location identity and transaction cost at column 6, lines 18-23.

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As to claims 34 and 35, Joao teaches means for prompting customers to verify the displayed transaction costs and means for prompting customer to accept said displayed transaction costs in order to complete the transaction, see column 6, lines 36-50.

As to claim 36, Joao teaches means for accepting code information from customer's responding to transaction notifications, see column 6, lines 49-57.

As to claim 37, Joao teaches a method for controlling transaction using a wireless network as discussed above in claim 1. In the system of Joao the transaction amounts are determined at the point-of-sale, see column 5, lines 39-45. The system of Joao further teaches transmitting the transaction amounts over the wireless network to wireless devices, displaying the transaction amounts for customers using the wireless devices and completing the transactions by charging said transaction amounts to sources of funds identified by said customers as discussed above in reference to claims 26 and 27.

As to claim 38, Joao teaches identifying point-of-sale locations.

As to claim 39, Joao teaches that the wireless devices may be wireless telephones.

As to claims 44 and 45, they are rejected on substantially the same basis as claim 32 as discussed above.

As to claim 46, Joao teaches that the wireless devices can be wireless telephones.

As to claims 47 and 48, they are rejected on substantially the same basis as claims 22 and 23 and discussed above.

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As to claim 49, it is rejected on substantially the same basis as claims 14-17 as discussed above.

As to claim 50, Joao teaches that the informing means comprises a visual display on said wireless device.

As to claim 51, it is rejected on substantially the same basis as claim 26 as discussed above.

As to claim 52, Joao teaches means for entering verified financial data in a billing database, see column 16, lines 4-14.

As to claim 53, it is rejected on substantially the same basis as claim 5 as discussed above.

As to claims 54 and 55, they are rejected on substantially the same basis as claims 29 and 30 as discussed above.

As to claim 56, it is rejected on substantially the same basis as claim 49 as discussed above.

As to claim 57-59, they are rejected on substantially the same basis as claims 44 and 45 as discussed above.

As to claim 64, it is rejected on substantially the same basis as claim 31 as discussed above.

As to claim 65, it is rejected on substantially the same basis as claim 17 as discussed above.

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As to claim 66, Joao teaches a method of controlling a transaction at a point-of-sale location. The method of Joao teaches identifying a customer using a wireless device, identifying a transaction amount for said transaction and correlating the identified customer and identified transaction amount in a database.

As to claim 67, Joao teaches that the transaction is completed using a point-of-sale terminal at the point-of-sale location.

As to claim 68, Joao teaches calculating a transaction amount at the point-of-sale terminal and transmitting the transaction amount to a wireless network, see column 5, lines 35-40.

As to claim 69, while Joao does not explicitly state that the customer identifying step comprises identifying the wireless telephone and correlating the identified wireless telephone to a customer, the examiner asserts that this is inherent to his system. He contacts the customer by his wireless with no direct initiation from the customer other than the transaction at the point-of-sale, thus the customer's wireless number must be stored at the central processing center and be identifiable by information sent from the point-of-sale.

As to claim 70, it is rejected on substantially the same basis as claims 36 and 43 as discussed above.

As to claim 71, it is rejected on substantially the same basis as claim 32 as discussed above.

As to claim 72, it is rejected on substantially the same basis as claim 33 as discussed above.

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As to claim 73 and 74, they are rejected on substantially the same basis as claims 33 and 34 as discussed above.

As to claim 75, it is rejected on substantially the same basis as claim 65 as discussed above.

As to claim 77, it is rejected on substantially the same basis as claim 11 as discussed above.

As to claim 78 and 79, they are rejected on the same basis as claim 10 as discussed above.

As to claim 80-82, they are rejected on substantially the same basis as claims 6 and 7 as discussed above.

As to claim 83, it is rejected on substantially the same basis as claim 8 as discussed above.

As to claim 85, Joao teaches receiving a point of sale identifier from the customer and a plurality of transaction amount each having information which identifies the point-of-sale, see column 5, lines 34-40 and column 6, lines 17-25.

As to claim 86, it is rejected on substantially the same basis as claim 66 as discussed above.

As to claim 87, it is rejected on substantially the same basis as claim 67 as discussed above.

As to claim 88, it is rejected on substantially the same basis as claim 1 as discussed above.

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As to claim 89, it is rejected on substantially the same basis as claim 39 as discussed above.

As to claim 90, it is rejected on substantially the same basis as claim 25 as discussed above.

As to claim 91, it is rejected on substantially the same basis as claim 32 as discussed above.

As to claim 92, it is rejected on substantially the same basis as claim 40 as discussed above.

As to claim 93, it is rejected on substantially the same basis as claim 2 as discussed above.

As to claim 94, it is rejected on substantially the same basis as claim 65 as discussed above.

As to claim 96, it is rejected on substantially the same basis as claim 77 as discussed above.

As to claim 97, it is rejected on substantially the same basis as claim 79 as discussed above.

As to claim 98, it is rejected on substantially the same basis as claim 66 as discussed above.

As to claim 99, it is rejected on substantially the same basis as claim 5 as discussed above.

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As to claim 101, it is rejected on substantially the same basis as claim 66 as discussed above.

As to claim 102, Joao teaches that the database comprises data which links individual wireless devices to individual customers through the direct dial number of these devices. This is inherent to Joao, see discussion of claim 12 above.

As to claim 103, it is rejected on substantially the same basis as claim 13 as discussed above.

As to claim 104, it is rejected on substantially the same basis as claim 66 as discussed above.

As to claim 105, it is rejected on substantially the same basis as claim 1 as discussed above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 10, 20, 22, 40-43, and 60-63 rejected under 35 U.S.C. 103(a) as being unpatentable over Joao.

As to claim 8, Joao differs from the claims of the instant application in that he does not suggest or disclose that the source of funds is an account with a wireless service provider.

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However, the examiner asserts that given the ubiquitous nature of 900 numbers that it was well known at the time of the invention to utilize the telephone access provider as a third party biller. As such no patentable distinction is imparted.

As to claim 10, Joao does not explicitly teach means for allowing each customer to identify the source of funds before the transaction occurs. However, he does state using debit, credit or other currency cards, at column 4, lines 25-30. In view of this, it would have been obvious to one of ordinary skill in the art to have allowed the customer to designate the source of the funds. Additional support for this is gleaned from the fact that point-of-sale payment terminals are known to accept various payment instruments, thus a system seeking to replicate these point-of-sale terminals using a customer's wireless device to approve transaction would be expected to incorporate this same flexibility.

As to claim 20, it is rejected on substantially the same basis as claim 8 as discussed above.

As to claim 22, it is rejected on substantially the same basis as claim 10 as discussed above.

As to claim 40, Joao does not explicitly teach that the customer select point-of-sale locations using a series of menus displayed on said wireless devices. However, he does teach that information including the name of the point-of-sale location is transmitted and displayed on the wireless device, at column 6, lines 17-21. Additionally, wireless devices such as phones and pagers typically utilize menus for displaying information because of their limited screen sizes.

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As a result, the examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized menus to display the point-of-sale location.

As to claim 41, Joao differs from the instant application in that he does not explicitly teach the step of identifying customers. However, the examiner takes official notice that using PIN numbers, electronic signatures, or biometrics are notoriously well known as a means of uniquely identifying a person using a financial instrument at the point-of-sale. The motivation to employ this measure is to reduce the number of fraudulent charges made to an account.

As to claims 42 and 43, they are rejected on substantially the same basis as claim 41 as discussed above.

As to claims 60-62, Joao does not explicitly teach identifying customers geographic area by the cell site they are out of, however, the examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention. Cell phones send out beacon signals every few seconds to the nearest cell phone tower. This way, when someone receives a call on the cell phone, the network only has to broadcast it over the closest tower in the network and not every tower in the network. As a result wireless networks always know where their customer's are located. As a result, one would have motivated to make use of this information in any system which sought to contact people via their wireless phones to minimize redundant and unnecessary broadcasts and use of bandwidth.

As to claim 63, it is rejected on substantially the same basis as claim 41 as discussed above.

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5. Claims 9, 21, and 84 rejected under 35 U.S.C. 103(a) as being unpatentable over Joao as applied to claims 1-8, 9-19, 21-83, 84-105 above, and further in view of Egendorf, US 5,794,221

Claims 9, 21 and 84 all state that the source of funds is an account with an Internet service provider. While Joao makes no explicitly mention of this he does anticipate various accounts at the customers discretion. The examiner asserts that third party billing arrangements whereby an Internet service provider (herein after ISP) does the billing for vendors were well known at the time of invention. Support for this is gleaned from Egendorf which teaches a billing system whereby the ISP bills customer for purchases from vendors. As a result, it would have been obvious to one of ordinary skill in the art to have modified the system of Joao to allow the billing account to have been an account with an ISP.

Allowable Subject Matter

6. Claims 76 and 95 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: Claims 76 and 95 disclose crediting the transaction amount to an account selected by a merchant at the point-of-sale location. There is no suggestion or disclosure of this in Joao.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, Hughes et al, US 5,754,655 for teaching a system for remote purchase payment and


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remote bill payment transactions, Vek et al, for teaching an ATM/POS based electronic mail system, Wireless Week, "General Magic going after success," March 11, 1996, p.32, Wines, Leslie, "Taking technology in hand," Journal of Business Strategy, v.17, n.1, pp. 36-40, Jan/Feb 1996, PR Newswire, "Visa Interactive, Sony and General Magic unveil hand-held solution for remote banking," February 27, 1996, Corbett, Merlisa, "Choosing the perfect PDA," Black Enterprise, v.26, n.6, pp. 34-35, January 1996, Newsbytes News Network, "Portable Wireless Banking with Sony Magic Link," March 1, 1996.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Groutt, whose telephone number is (703) 305-2398. The examiner can usually be reached Monday through Friday, from 8:30 am to 5:00 pm.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached at (703) 305-9714. The fax number for this group is (703) 305-0400.

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STEPHEN R. TKACS
PRIMARY EXAMINER